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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/599,679

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Robert J. Brockway

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07/06/2009

ZIOLKOWSKI PATENT SOLUTIONS GROUP, SC (ZPS)

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PORT WASHINGTON, WI 53074

EXAMINER

STORMER, RUSSELL D

ART UNIT

PAPER NUMBER

3617

NOTIFICATION DATE

DELIVERY MODE

07/06/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

09/599,679

Applicant(s)

BROCKWAY, ROBERT J.

Examiner

Russell D. Stormer

Art Unit

3617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 March 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23, 25 and 29-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-12 and 14-19 is/are allowed.
- 6) ☒ Claim(s) 13, 21, 22, 23, 25, and 29-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

Reissue Applications

Claims 13, 21-23, 25, and 29-31 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based.

See *Pannu v. Storz Instruments Inc.*, 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001); *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to claim subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope of claim subject matter surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

In the amendment filed March 13, 2009, claims 13, 21, 23, 25, and 30 are broadened to exclude subject matter that was surrendered in the original application. Specifically, the limitation of the axle guard system including a "cleat-free area" which extends widthwise from the inner edge of the rim "at least about the width of one of said cleats" is not present in the claims.

During prosecution of the original patent this limitation was argued as defining over the references of record. See the Remarks filed with the amendments of August 7,

1997 and December 16, 1997 in which it is argued that "none of the references of record disclose, teach, or suggest a compaction wheel having an axle guard system, as taught by the present specification." The "axle guard system" in this instance is defined by the last three lines of claim 1. Any reissue claims broadened by deleting limitations from these last three lines is improper recapture of subject matter surrendered in the application of the original patent.

In the amendment filed March 13, 2009, claims 23 and 25 are broadened to exclude subject matter that was surrendered in the original application. Specifically, the limitation that the inner circumferential edge of the rim includes "adjacent to one side of said body" has been deleted and replaced with the limitation of the inner edge - -being closer to said body than said outer circumferential edge- - which was part of patented original claim 14.

During prosecution of the original patent this limitation was added to claim 14 and argued as defining over the references of record. See the Remarks filed with the amendments of August 7, 1997 and December 16, 1997 in which it is that claim 14 has been amended to more clearly recite "distinctions" that are argued to be absent from the teachings of the prior art of record. Claims 23 and 25 have been broadened by deleting these limitations, and therefore improperly recapture subject matter surrendered in the application of the original patent.

In the amendment filed March 13, 2009, claim 30 is broadened to exclude subject matter that was surrendered in the original application. Specifically, the limitation that the plurality of "compaction cleats circumferentially spaced on, transversely spaced across and mounted to" the face of the rim which was part of patented original claims 1 and 6.

During prosecution of the original patent these limitations were added to claims 1 and 6 and argued as defining over the references of record. See the Remarks filed with the amendment of August 7, 1997 in which the "compaction cleats" and the "compaction wheel" are argued as not being disclosed by the references of record and that claims 1 and 14 have been amended to more clearly recite "these distinctions."

Further, the amendment filed December 16, 1997 includes in the Remarks, arguments that the references of record do not disclose a "compactor wheel" and "compactor cleats" as recited in claims 6-8, and a statement that "claim 6 has been amended to more clearly recite these distinctions" which are argued to be absent from the teachings of the prior art of record. Further, in the interview of December 19, 1997 it was agreed that claim 6 would be amended to include limitations found in claim 1 by inserting the term - on, transversely spaced across- - after the word "spaced" in line 9 of claim 9. Because claim 30 has been broadened by deleting these limitations, it therefore improperly recaptures subject matter surrendered in the application of the original patent.

Remarks

The finding of recapture is based on current U.S. Patent and Trademark Office practice. While the claims filed in this Reissue application were previously considered to avoid a rejection based on improper recapture, that view has now changed with the Office no longer following the decision in *Ex parte Eggert*, USPQ2d, 1716 (Bd. Pat. App. & Inter. 2003). It is regretted that it was not realized that the changes in Office policy regarding recapture would be applicable to this Reissue application until after Applicant's amendment of March 13, 2009.

The finding of Recapture set forth above is consistent with the procedures outlined in MPEP 1412.02. Specifically, under the three-step test, (A) the Reissue application does include claims which are broadened; (B) the broadening does relate to surrendered subject matter; and (C) the claims were not materially narrowed in other respects.

With respect to (B) The Second Step, the first Sub-Step is applicable because the omitted or broadened limitations as set forth in the rejections above were relied upon by Applicant in the original patent application to make the claims allowable over the prior art. Please refer to the limitations of "at least the width of one of said cleats;" "adjacent to one side of said body;" "transversely space across;" and "compaction cleats," "compactor wheel," "circumferentially spaced on," and "mounted on" omitted from the claims as set forth in the rejection above.

With respect to first Second-Step of (B) The Second Step, these limitations were argued by Applicant without amendment and/or the claims were amended without a specific argument to those limitations.

With respect to (C) The Third Step, the Reissue application presents claims with omitted or broadened limitations; and the broadened claims do **not** include additional limitations that would materially narrow the claims in other respects, and thus do not avoid the recapture rule.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Russell D. Stormer whose telephone number is (571) 272-6687. The examiner can normally be reached on Monday through Friday, 9 AM to 4 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Morano can be reached on (571) 272-6684. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Russell D. Stormer/
Primary Examiner, Art Unit 3617